

REMARKS

Applicants respectfully request reconsideration of this application as amended. Claims 1, 8, 17 and 21 have been amended. Claims 11-16 and 18 have been previously canceled. Therefore, claims 1-10, 17 and 19-25 now are presented for examination.

35 U.S.C. § 112 Rejection

Claims 1-10, 17 and 19-25 stand rejected under 35 U.S.C. §112, second paragraph. Claims 1, 8, 17 and 21 have been amended to place the claims in proper condition for allowance. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. §112, second paragraph be withdrawn.

35 U.S.C. § 103 Rejection

Claims 1-10 and 17-25 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Reilly, U.S. Patent No. 6,427,164 (“Reilly”) in view of Gilchrist, U.S. Patent No. 5,768,505, (“Gilchrist”), and in further view of Japanese Application No. 2000259514, published on September 22, 2000 (“JP259514”), in view of Applicant’s admitted prior art.

Applicant respectfully submits that Reilly discloses “[s]ystems and methods for automatically determining the recipient of electronic mail that is unknown at the receiving server [but] has left a ‘forwarding address’ . . . thereby. . . automatically *send[ing] the electronic mail content to the correct new address*. In addition, “*the sending user is notified as to the new electronic mail address so as to allow the sending user to update manually, or automatically, the user’s individual database of electronic mail addresses.*” (Abstract; emphasis provided).

Gilchrist discloses “[a] framework for use with object-oriented programming systems [that] provides a common message processing system structure that can be placed on any OOP platform and be configured to support any e-mail message protocol standard or specific mail server function.” (Abstract).

Claim 1, in pertinent part, recites “automatically deleting the destination address for the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages.” (emphasis provided). Applicant submits that neither Reilly nor Gilchrist teach or reasonably suggest such a feature. The Examiner in an Office Action mailed July 1, 2005 states that “Reilly, in view of Gilchrist does not teach . . .” the feature recited above. (Office Action, mailed July 1, 2005, page 4, line 15-17). Instead, the Examiner relies on JP259514 as teaching recites “automatically deleting the destination address for the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages” as recited by claim 1. (emphasis provided).

However, Applicant submits that JP259514 is not prior art under 35 U.S.C. §102(e)/§103(a). 35 U.S.C. §102(e)(1) states that in order for a reference to be considered prior art, the reference must be “an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.” (35 U.S.C. §102(e)(1); emphasis added). JP259514 was never filed in the United States.

35 U.S.C. §102(e)(2) states that “except that an international application filed under the treaty . . . shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English

language.” (35 U.S.C. §102(e)(2); emphasis added). An international application under the treaty means an application filed with the PCT. JP259514 is a Japanese Patent Application, not a PCT (international) application designating the United States. Accordingly, Applicant respectfully submits that JP259514 is not prior art, and respectfully requests that the rejection of claim 1 and its dependent claims be withdrawn.

Claims 8, 17 and 21 include limitations similar to those in claim 1. Accordingly, for the reasons stated above with respect to claim 1, Applicant respectfully requests the withdrawal of the rejection of claims 8, 17 and 21 and their dependent claims.

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Invitation for a Telephone Interview

The Examiner is requested to call the undersigned at (303) 740-1980 if there remains any issue with allowance of the case.

Request for an Extension of Time

Applicants respectfully petition for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17(a) for such an extension.

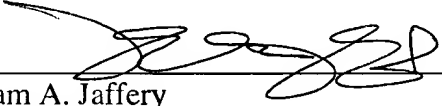
Charge our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: September 30, 2005


Aslam A. Jaffery
Reg. No. 51,841

12400 Wilshire Boulevard
7th Floor
Los Angeles, California 90025-1030
(303) 740-1980